IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. 09/441,729
Filing Date ..... November 16, 1999
Inventorship ..... Bloch
Assignee ..... Microsoft
Group Art Unit 2697
Examiner ..... M. Demicco
Attorney's Docket No. MS1-1073US
Title: Seamless playback of multiple clips of media data across a data network

REQUEST FOR REHEARING (APPEAL NO. 2005-2523)

TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

OF THE UNITED STATES PATENT OFFICE

To: Board of Patent Appeals and Interferences
PO Box 1450
Alexandria, VA 22313-1450 (Fax: 571-273-0052)

From: Brian J. Pangrle
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Request for Rehearing

Appellant requests rehearing under 37 CFR §41.52 (MPEP §1214.03). Appellant states with particularity the points believed to have been misapprehended or overlooked by the Board (Appeal No. 2005-2523; Decision mailed October 27, 2005).

Appellant respectfully submits that the Board's Decision fails to answer the specific factual question that gave rise to this Appeal. Appellant submits that facts relied on by the Examiner were misapprehended by the Board and that facts relied on by Appellant were overlooked by the Board.

The Board's Decision at page 12 states: "Contrary to appellants' arguments the claims do not include a limitation of transmitting "digitized video data". While independent claim 1 and independent claim 7 do not recite "digital" explicitly, the record prior to Appeal demonstrates that the Examiner and the Appellant understood that the term "rendering" referred to rendering of digital media data. This issue was not in dispute. Rather, the Examiner and Appellant disagreed as to the digital media data rendering capabilities of the Langford reference's off-line edit controller 30.

The Board's decision appears to interpret the claims (Decision at page 6) in a manner that accords insufficient weight to the overall meaning of "rendering", and its relationship to "media data", established in the record prior to Appeal and maintained on Appeal. As the Board is keenly aware, patentees are typically held to statements made in the prosecution record under theories such as Prosecution History Estoppel. Indeed, such statements are considered intrinsic evidence and have been used to interpret claim scope. Per the MPEP §2173.02:

> As noted by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002), a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process."

As explained below, "rendering" was understood by the Examiner and Appellant to be rendering of digital media data. The Board's decision appears to use new, broadened definitions for the terms "rendering" and "media data", which, in turn, leads to a position that differs from that of the Examiner. If the Board agrees with Appellant upon a grant for rehearing, then Appellant respectfully requests that the Board:

(A) Reverse the Examiner and optionally state new grounds of rejection (37 CFR §41.50(b); see, e.g., In re Kumar, 418 F.3d 1361 (Fed.

Cir. 2005) (appellant entitled to respond to the evidence adduced sua sponte by the Board)); and/or

(B) Recommend amendment of the claims to explicitly include, for example, the word "digital" to thereby overcome any rejection based on the Langford reference (37 CFR §41.50(c)).

Appellant submits that either action will speed prosecution of the instant application.

Meaning of "Rendering" and "Media Data"

Appellant first refers to the record prior to Appeal, as to the meaning of "rendering" and understanding that the media data was "digital", and then to the record on Appeal. Thereafter, Appellant refers to the Board's Decision.

Record Prior to Appeal

1. The Examiner recognized the existence of a "renderer" in the specification (Office Action mailed August 12, 2003 at page 2) for rendering. In particular, the Examiner requested a change in spelling from "renderor" to "renderer". Item 210 of Fig. 2 of the instant application is a "decompressor/renderer". Per the specification at page 2, lines 19-23:

> The decompressor/renderer 210 is responsible for decompressing the video and audio and presenting them to the display 208 in correct synchronization. Note that decompression is only required if movie data is stored in a compressed format (e.g., MPEG, etc.).

2. The Examiner proffered the following definition for "rendering": "To convert (graphics) from a file into visual form, as on a video display" (Final Office Action mailed April 7, 2004 at page 2). The record indicates that such a file is understood to be a digital file; hence, rendering must logically render digital data from a digital data file.

3. The Examiner understood that the recited "rendering" was of digital data. "It is also possible for the laser disk player [e.g., item 501 to

produce a digital bit stream that will be converted into visual form by another device" (Final Office Action mailed April 7, 2004 at pages 2 and 3). Again, at issue is whether the off-line edit controller 30 can, as "another device", perform rendering of digital data. Appellant says "no" and the Examiner says "yes".

Record on Appeal

1. Appellant disagreed with the Examiner's contention that the Langford reference's off-line edit controller 30 could: (i) receive digital media data and (ii) could render digital media data. In Appellant's Opening Brief at page 11, the following evidence was cited for the proposition that the Langford reference did not disclose rendering of digital media data:

> [T]he Langford discloses at col. 15, lines 18-30:
> . . . In one class of embodiments of the invention, video takes are displayed directly on monitor 35 within windows 441-446, rather than icons representing video takes elsewhere displayed. For example, this may be accomplished by connecting conventional picture-in-picture circuitry between recorders 50 and monitor 35 . . . .

2. The Examiner's Answer at pages 5-6 maintained that rendering was of digital data: "Therefore, the act of communicating video data stored on a disk drive (50) for display on a computer (30) monitor (35) in a window (140-145) of a graphical user interface clearly reads on the claimed rendering". Here, the Examiner maintains that rendering is of digital data ("video data stored on a disk drive"), as understood prior to Appeal, yet maintains that the computer 30 can (i) receive digital media data from the disk drive 50 and (ii) render such data. Again, Appellant disagrees.

Board's Decision

The Board's Decision at page 8 states: "Additionally, on page 4 of the reply brief, appellants take exception to the examiner's interpretation of the term 'rendering', without proffering an alternative; rather, appellants' arguments focus on the random access memory units providing video signals and not media

data". This is an incorrect interpretation of Appellant's position and the specific factual issue on Appeal.

Appellant did not disagree with the interpretation of the term "rendering" but rather that the random access memory units did not provide digital media data to the off-line edit controller 30. As a logical consequence, Appellant maintained that the off-line edit controller 30 could not possible render digital media data.

Appellant further maintains that there is absolutely no evidence to teach how the Langford reference's off-line edit controller or computer 30 (even its preferred IBM AT personal computer circa 1990) could possibly render digital media data. Instead, as stated in Appellant's Opening Brief at page 11, the Langford reference discloses display of video directly or use of "conventional picture-in-picture circuitry between recorders 50 and monitor 35". Appellant notes that the doubled-headed arrow between item 30 and 50 in Figure 2 of the Langford reference represents a control link, not a link for communication of digital media data.

Appellant further notes that the Langford reference lists Sony Corporation as assignee and refers to various types of Sony video and audio equipment. It may logically follow that the Langford reference is directed primarily to use of specialized Sony equipment and not to new capabilities of computer equipment manufactured by IBM (e.g., an IBM AT computer circa 1990).

More simply stated, the Langford reference provides no evidence that the off-line edit controller 30 receives media data and renders such data, as these terms were established in the record prior to Appeal and maintained on Appeal. Again, the record indicates that the Examiner and Appellant

understood that the term "media data" refers to digital data and that "rendering" renders digital data.

Requested Action

Appellant respectfully requests that the Board grant this Request for Rehearing and that the Board:

(A) Reverse the Examiner and optionally state new grounds of rejection (37 CFR §41.50(b); see, e.g., In re Kumar, 418 F.3d 1361 (Fed. Cir. 2005)); and/or

(B) Recommend amendment of the claims to explicitly include, for example, the word "digital" to thereby overcome any rejection based on the Langford reference (37 CFR §41.50(c)).

Appellant submits that either action will speed prosecution of the instant application.

Respectfully Submitted,

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Dated: 12/27/05

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Application Number: 09/441,729

Filing Date: 11/16/1999

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1. Request for Hearing To the Board of Patent Appeals
2. Fee Transmittal

Total pages including cover sheet: 8

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 0.00

Complete if Known	
Application Number	09/441,729
Filing Date	11/16/1999
First Named Inventor	Eric D. Bloch
Examiner Name	MATTHEW R DEMICCO
Art Unit	2611
Attorney Docket No.	MS1 1073US

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☑ Deposit Account Deposit Account Number: 12-0769 Deposit Account Name: Lee & Hayes, PLLC

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	FILING FEES Small Entity Fee ($)	SEARCH FEES Fee ($)	SEARCH FEES Small Entity Fee ($)	EXAMINATION FEES Fee ($)	EXAMINATION FEES Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

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2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee ($)	Small Entity Fee ($)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 20 or HP =	_____	x 50	= _____

HP = highest number of total claims paid for, if greater than 20

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	_____	x 200	= _____

HP = highest number of independent claims paid for, if greater than 3

Multiple Dependent Claims Fee ($)	Fee Paid ($)
_____	_____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
_____ - 100 =	_____	/ 50 = _____ (round up to a whole number)	x _____	= _____

4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	_____
Other: _____	_____

SUBMITTED BY			
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